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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,666	05/23/2001	Ronald Adams	06530.0279	1136
22852	7590	07/28/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			ODLAND, KATHRYN P	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/863,666	<b>Applicant(s)</b> ADAMS, RONALD	
	<b>Examiner</b> Kathryn Odland	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) 23-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/02, 1/3/03</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on May 27, 2004 is acknowledged. Applicant has amended claims 10 and 22 to depend from claim 1. Thus, these claims will now be examined with Group I. Claims 23-36 are withdrawn from consideration as being directed to a non-elected group. Applicant has not provided persuasive arguments to traverse. Thus, the restriction is deemed proper.

### ***Specification***

2. The disclosure is objected to because of the following informalities: a figure 6 is mentioned in BRIEF DESCRIPTION OF THE DRAWINGS section; however, there does not appear to be a corresponding drawing provided.

Appropriate correction is required.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Since there are many endoluminal funoplication devices a novel feature of the invention should be included in the title.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the light source connected to the endoscope as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Kortenbach in US Patent No. 6,068,600.

Regarding claim 1, Kortenbach discloses a distal assembly of an endoscopic surgical device having a first arm (34/18) and a second arm (40) pivotal relative to the first arm, each arm configured to hold a part of a two-part fastener at a distal end of the arm, as recited in column 7; a closing mechanism (via pivoting) positioned proximate a proximal end of each of the first and second arms opposite the distal end of each of the first and second arms, the closing mechanism configured to move in relation to the first and second arms so as to close over at least one of the first and second arms to cause the distal ends of the arms to come together; and an actuation member (such as 24 and associated components) attached to the closing mechanism actuatable to cause the closing mechanism to move in relation to the first and second arms, as recited throughout the specification and seen in the figures.

Regarding claim 2, Kortenbach discloses that as applied to claim 1, as well as, an actuation member (24) that is a cable, as recited in column 7, lines 35-40.

Regarding claim 3, Kortenbach discloses that as applied to claim 1, as well as, first and second arms that are straight, as seen in figure 3.

Regarding claim 4, Kortenbach discloses that as applied to claim 1, as well as, one of the first and second arms that are curved. No degree of curvature has been claimed. Thus, the curvature could be zero degrees.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kortenbach in US Patent No. 6,068,600 in view of Green et al. in US Patent No. 5,554,169.

Regarding claim 5, Kortenbach discloses that as applied to claim 4. However, Kortenbach does not recite a closing mechanism that is configured to close over the curved arm. On the other hand, Green et al. disclose a collar (127) configured to close the jaws, as recited in column 9, lines 5-15. Thus, it would be obvious to modify the invention of Kortenbach to include a closing sheath for the purpose of enhanced closing with equal force distribution.

Regarding claims 6 and 7, Kortenbach discloses that as applied to claim 1. However, Kortenbach does not recite a spring at a pivot between the first and second arms. On the other hand, Green et al. disclose a collar (127) configured to close the jaws, as recited in column 9, lines 5-15. Therefore, it would be necessary to bias the jaws to the open position. Thus, it would be obvious to modify the invention of Kortenbach to include a closing sheath for the purpose of enhanced closing with equal force distribution, where a bias would be necessary and a spring would be an obvious bias to

open the jaws. Further, this modification would yield a force to cause the distal ends of the arms to be pushed apart.

Regarding claim 8, Kortenbach discloses that as applied to claim 1. However, Kortenbach does not recite an actuation member that includes an elongate member having a threaded end that mate with a threaded hole in the closing mechanism. On the other hand, Green et al. disclose a collar (127) configured to close the jaws, as recited in column 9, lines 5-15. Therefore, it would be necessary to bias the jaws to the open position. Thus, it would be obvious to modify the invention of Kortenbach to include a closing sheath for the purpose of enhanced closing with equal force distribution. Given this modification, it would be obvious to include an actuation member that includes an elongate member having a threaded end that mate with a threaded hole in the closing mechanism.

Regarding claim 9, Kortenbach discloses that as applied to claim 1. However, Kortenbach does not recite a closing mechanism includes a tube. On the other hand, Green et al. disclose a collar (127) configured to close the jaws, as recited in column 9, lines 5-15. Thus, it would be obvious to modify the invention of Kortenbach to include a closing sheath for the purpose of enhanced closing with equal force distribution.

9. Claims 10-11, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kortenbach in US Patent No. 5,554,169.

Regarding claim 10, Kortenbach discloses that as applied to claim 1, as well as, a flexible endoscope (2) configured to be guided along the endoscope. Although, a stop mechanism located on the endoscope and configured to stop the advancement of the tissue fastening tool at a location relative to the endoscope is not explicitly recited, it would be obvious to one with ordinary skill in the art to provide a stop mechanism for the purpose of precise location and attachment.

Regarding claim 11, Kortenbach as modified discloses that as applied to claim 10. Further, a stop mechanism that includes a ring is within the scope of this modification and would be obvious to one with ordinary skill in the art.

Regarding claims 21 and 22, Kortenbach discloses that as applied to claim 1. Further, an endoscope having comprises a distal assembly including a housing having a first light source and imaging system facing a distal direction and a second light source and imaging system facing a proximal direction opposite the distal direction would be obvious to one with ordinary skill in the art, for there are numerous types of endoscopes and endoscope attachments available that could be used with that system.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).



A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 5-7 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 19 of copending Application No. 10/724740. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely reworded representations for the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

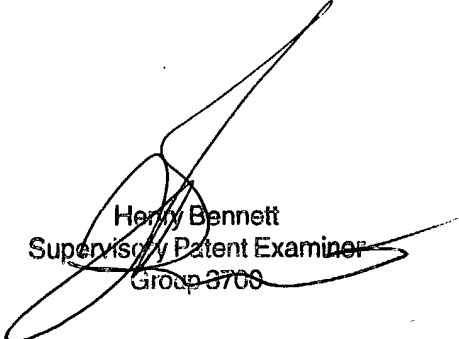
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,743,239; US Patent No. 6,461,363; US Patent No. 5,906,625; US Patent No. 5,897,562; and US RE37,814.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



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